

REMARKS

Claims 1-10 are pending in this application. Claims 1-10 are rejected. Claim 1 is herein amended. Attached hereto is a marked-up version of the changes made by the current amendment, captioned "Version with Markings to Show Changes Made."

Claim Rejections under 35 U.S.C. §112

Claims 1-3 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "finely divided" in claim 1 is a relative phrase which renders the claim indefinite.

Applicants herein amend the claim to read, "a ~~finely divided~~ tabular mineral (T)".

Double Patenting

Claims 5, 6, 9 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 and 4 of U.S. Patent No. 6,423,408 B2 to Okamoto et al. ("Okamoto '408") in view of U.S. Patent No. 6,211,500 B1 to Cochran II et al.

Applicants submit herewith a Terminal Disclaimer that disclaims the portion of any resulting patent that extends beyond the expiration date of Okamoto '408. Applicants submit that this overcomes the double patenting rejection over Okamoto '408.

Claim Rejections under 35 U.S.C. §103

Claims 1-5, 7 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,156,817 to Okamoto et al. ("Okamoto '817") in view of U.S. Patent No. 6,211,500 B1 to Cochran II et al.

Applicants note that Okamoto '817 is commonly assigned with the present application. We further note that Okamoto '817 is only available as a reference under 35 U.S.C. §102(a) or (e), and not under § 102 (b), (c), or (d).

Applicants further note that the present invention was filed on January 30, 2001, but is based on Japanese Application 2000-025730 filed February 2, 2000. Applicants submit that this foreign priority removes Okamoto '817 from use as a reference under 35 U.S.C. §102(a). Applicants are currently preparing an Verified Translation of the priority document, and will forward this document to the Patent Office as soon as it is ready. Therefore, Applicants submit that the cited reference is not available for use in a rejection under 103, based on it being a reference under 102(a).

Applicants further note that under 35 U.S.C. §103(c), a reference such as Okamoto '817 is not useable as a reference under 35 U.S.C. §103(a) if it is subject to an obligation of assignment to the same entity. Applicants confirm that both the present invention and the cited reference are subject to an obligation of assignment to Kabushiki Kaisha Eribu. Therefore, Applicants submit that this reference is no longer available for the rejection under 35 U.S.C. §103(a), and submit that the rejection should be withdrawn.

For at least the above reasons, Applicants submit that the present amendment and associated terminal disclaimer obviate the rejections of record.

Amendment under 37 C.F.R. §1.111
Hiroshi OKAMOTO et al.

U.S. Patent Application Serial No. 09/771,700
Attorney Docket No. 010064

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees that may be due with respect to this paper to Deposit Account No. 01-2340.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

Enclosures: Version with markings to show changes made
Terminal Disclaimer

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend claim 1 as follows:

1. (Amended) A functional composition comprising mixture of a plant-originated functional component (A), a ~~finely divided~~ tabular mineral (T) having a low hardness and cleavage, and a ceramics component (C) other than the ~~finely divided~~ tabular mineral (T).